

### **REMARKS**

The Applicants have included the claims that were withdrawn due to a restriction requirement. Applicants erred in filing an RCE on 19 May 2006 and wish to retract the request for RCE and re-submit the Remarks made in response to the Examiner's rejections. The following remarks are the remarks submitted on 19 May 2006:

#### ***Remaining Claims***

Seven (7) claims remain pending in this application through this Amendment.

#### ***Oath/Declaration***

A corrected oath and declaration will be submitted by separate correspondence.

#### ***Specification***

Applicants have amended the specification.

#### ***Claim Rejections under 35 U.S.C §103***

Claims 1-6 were rejected under 35 U.S.C. §103 (a) as being "unpatentable over Israel (U.S. Patent No. 6139145) in view of Zhang et al. (U.S. Patent No. 5997140.)"

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggested the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Both Israel and Zhang are related to vision correction and describe possible use of holograms; however, combining them absent a teaching or suggestion to do so is improper and runs afoul of the standards set forth by the USPTO for obviousness-type rejections

In *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) the court concluded that the Board "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention[to have

been] obvious." *Id.* at 1357, 47 USPQ2d at 1457. The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." *Id.*

The combination of Israel and Zhang is unacceptable. Neither reference suggests the combination. These two references in fact, teach away from one another, as has been previously stated by the Applicants. There is simply no suggestion to combine these references.

Further evidence that these two references cannot be combined to support an obviousness-type rejection is that Israel must be modified to be combined with Zhang, which destroys the intended function of Israel. Israel, as stated in the RCE and Amendment filed on 09 June 2005 is designed to shift an image to a healthy portion of the retina (other than the fovea) to overcome macular degeneration. The present invention uses only one optical power at a time to form a clearly perceivable image along the wearer's line of sight, more specifically at the fovea." (emphasis added). Forming a clearly perceivable image at the fovea destroys the intent of Israel, which moves an image away from the fovea. The CCPA and the Federal Circuit have consistently held that when a 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the prima facie case cannot be properly made. See, e.g., *In re Gordon*, 733F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Altering Israel in such a way as to combine it with Zhang for the purpose of rendering the present application obvious would destroy the intent, purpose and function of Israel. As such, the combination of Israel and Zhang is improper.

In summary, the combination of Israel with Zhang is improper because there is no teaching or suggestion to do so and such combination would destroy the intent, purpose and function of Israel.

**CONCLUSION**

For the foregoing reasons, Applicants submit that Claims 1-7 are patentable over the cited art. Applicant respectfully requests reconsideration and withdrawal of the claim rejections set-forth in the Office Action and allowance of claims 1-7.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Rob Gorman, CIBA Vision Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

Respectfully submitted,



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